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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,163	01/28/1999	HIROSHI SUMIYAMA	032567-002	6659

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT PAPER NUMBER

2625

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/238,163

Applicant(s)

SUMIYAMA ET AL.

Examiner

Joseph R. Pokrzywa

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS; WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 6-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 23 is/are allowed.
- 6) ☒ Claim(s) 1,4,6-12,14-18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 5/10/06, and has been entered and made of record. Currently, **claims 1, 4, and 6-23** are pending.

Response to Arguments

2. Applicant's arguments filed 5/10/06 have been fully considered but they are not persuasive.

3. In response to applicant's arguments regarding the rejection of **claim 1**, which was cited in the Office action dated 2/10/06 as being anticipated by Kawabuchi *et al.* (U.S. Patent Number 5,740,496), whereby applicant argues that Kawabuchi fails to teach of discarding image data while maintaining associated image forming conditions, as applicant states that Kawabuchi is seen as discarding a print job that is printing or print job that is being read, together with the associated set mode data. As read in column 8, lines 62-67, Kawabuchi states that "When the printing image data clear report is received, the read pointer is set to page 1 (S104), the print job pointer is set to the next block (S105), and the set number is set to 1 (S106), in order to discard image data of the job which is being printed." Further, as read in column 5, lines 24-29, Kawabuchi states that "information in management table MT1 is erased when information corresponding to one page is read out for the number of times corresponding to the desired number of copies, from code memory 306." Continuing, Kawabuchi states in column 10, lines 5-16, that "after the clear key is 93 is pressed, when the job which is being read is to be

Art Unit: 2625

abandoned, the user touches selection key L1, and if the job which is being printed is to be abandoned, the use[r] touches selection key L2.” Thus, the images corresponding to the reading job that are subsequently printed under the conditions set forth in the MTI, can be erased independently from the printing data by pressing either the L1 key or the L2 key, as seen in Fig. 23 and read in the abstract. Because of this, Kawabuchi can be interpreted as discarding the image data stored in the first memory when the command of discarding the image data is generated by the command unit (whereby the image data corresponding to the reading job is erased), while maintaining the associated image forming conditions stored in the second memory (being the data in the set data in the MTI for the printing job).

4. Therefore, the rejection of independent **claim 1**, as well as independent **claims 10 and 16**, and each of the corresponding dependent claims, which were cited in the Office action dated 2/10/06 under 35 U.S.C. 102(e) as being anticipated by Kawabuchi *et al.*, is maintained and repeated in this Office action.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1, 4, 6-12, 14-18, and 20-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Kawabuchi *et al.* (U.S. Patent Number 5,740,496, cited in the Office action dated 2/10/06).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

Art Unit: 2625

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding **claim 1**, Kawabuchi discloses an image forming apparatus (see abstract, and Fig. 1) comprising a first memory for storing image data (memory unit 30, column 4, lines 37-45), an image input unit for inputting the image data to the first memory (column 2, line 55-column 3, line 49), a second memory for storing image forming conditions (being the management table MTI stored in the RAM 126, column 4, line 37-column 5, line 7), the image forming conditions being at least one of number of copies, and magnification (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7), an image output unit for printing the image stored in the first memory under the image forming conditions stored in the second memory (column 6, lines 23-40), a command unit for generating a command of discarding the image data being printed by the image output unit (see abstract, and column 8, line 49-column 9, line 16), an image data discarding controller for discarding the image data stored in the first memory when the command of discarding the image data is generated by the command unit (see abstract, and column 8, line 49-column 9, line 16), while maintaining the associated image forming conditions stored in the second memory (column 9, line 17-column 10, line 29), a job stopping controller for stopping a print operation of a job being printed by the image output unit (see abstract, and column 8, line 49-column 9, line 16), and an output control unit for causing the output unit to output image data newly input from the image input unit after the discarding of image data from the first memory under the maintained image forming conditions (column 3,

Art Unit: 2625

line 50-column 4, line 22, and column 9, line 17-column 10, line 29), wherein the command unit generates a command of discarding the image data of the job stopped by the job stopping controller (see abstract, and column 8, line 49-column 9, line 16), and wherein the image data discarding controller discards the image data of the job stopped by the job stopping controller and maintains the image forming conditions of the job (see abstract, and column 8, line 49-column 9, line 16).

Regarding **claim 4**, Kawabuchi discloses the image forming apparatus discussed above in claim 1, and further teaches of means for changing the maintained image forming conditions (column 3, line 55-column 5, line 7).

Regarding **claim 6**, Kawabuchi discloses the image forming apparatus discussed above in claim 1, and further teaches that the image input unit is an image reader for reading the image from the original and acquiring the image data, wherein the image output unit and the image reader operate independently (column 2, line 55-column 3, line 60).

Regarding **claim 7**, Kawabuchi discloses the image forming apparatus discussed above in claim 6, and further teaches that when the image reader is reading another original, the command unit generates a command of suspending the reading operation, and at the same time, it generates a command of discarding the image data to be printed (see abstract, and Fig. 23, column 9, line 4-column 10, line 29).

Regarding **claim 8**, Kawabuchi discloses the image forming apparatus discussed above in claim 6, and further teaches that when the image reader is reading another original, the command unit generates a command of discarding the image data to be printed after the reading operation

for another original has been completed (column 3, line 50-column 4, line 67, and column 8, line 57-column 9, line 16).

Regarding **claim 9**, Kawabuchi discloses the image forming apparatus discussed above in claim 1, and further teaches that the image output unit is a printer for printing an image on a paper based on the image data (column 2, line 55-column 3, line 60).

Regarding **claim 10**, Kawabuchi discloses an image forming apparatus (see abstract, and Fig. 1) comprising an image for reading an original and acquiring image data of the original (column 2, line 55-column 3, line 49), an image memory for storing image data acquired by the image reader (memory unit 30, column 4, lines 37-45), a mode memory for storing image forming conditions selected for the acquired image data (being the management table MTI stored in the RAM 126, column 4, line 37-column 5, line 7), the image forming conditions being at least one of number of copies, and magnification (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7), a printer for printing an image on paper, based on the image data stored in the image memory, under the image forming conditions stored in the mode memory (column 6, lines 23-40), a command unit for generating a command of discarding the image data being printed by the printer (see abstract, and column 8, line 49-column 9, line 16), an image data discarding controller for discarding the image data stored in the image memory when the command of discarding the image data is generated by the command unit (see abstract, and column 8, line 49-column 9, line 16), while maintaining the associated image forming conditions stored in the mode memory (column 9, line 17-column 10, line 29), a print control unit for causing the printer to print another image data newly read by the image reader after the discarding of image data from the image memory under the maintained image forming

Art Unit: 2625

conditions in the mode memory (column 3, line 50-column 4, line 22, and column 9, line 17-column 10, line 29), and a job stopping controller for stopping a print operation of a job being printed by the printer, wherein the command unit generates a command of discarding the image data of the job stopped by the job stopping controller (see abstract, and column 8, line 49-column 9, line 16), and wherein the image data discarding controller discards the image data of the job stopped by the job stopping controller and maintains the image forming conditions of the job (see abstract, and column 8, line 49-column 9, line 16).

Regarding **claim 11**, Kawabuchi disclose the image forming apparatus discussed above in claim 10, and further teaches of a changing means for changing the maintained image forming conditions (column 3, line 55-column 5, line 7).

Regarding **claim 12**, Kawabuchi disclose the image forming apparatus discussed above in claim 10, and further teaches that the image reader and the printer operate independently (column 2, line 55-column 3, line 60), and the image memory stores image data for a plurality of jobs (column 4, lines 22-61).

Regarding **claim 14**, Kawabuchi discloses the image forming apparatus discussed above in claim 12, and further teaches that when the image reader is reading another original, the command unit generates a command of suspending the reading operation, and at the same time, it generates a command of discarding the image data to be printed (see abstract, and Fig. 23, column 9, line 4-column 10, line 29).

Regarding **claim 15**, Kawabuchi discloses the image forming apparatus discussed above in claim 12, and further teaches that when the image reader is reading another original, the command unit generates a command of discarding the image data to be printed after the reading

Art Unit: 2625

operation for another original has been completed (column 3, line 50-column 4, line 67, and column 8, line 57-column 9, line 16).

Regarding *claim 16*, Kawabuchi discloses an image forming method (see abstract) comprising storing image data in an image memory (memory unit 30, column 4, lines 37-45), storing image forming conditions for the image data in a memory (being the management table MTI stored in the RAM 126, column 4, line 37-column 5, line 7), the image forming conditions being at least one of number of copies, and magnification (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7), printing an image on a paper, based on the image data stored in the image memory, under the image forming conditions stored in the memory (column 6, lines 23-40), generating a command of discarding the image data whose image is being printed (see abstract, and column 8, line 49-column 9, line 16), stopping a print operation of the image data being printed and erasing the image data from the image memory in response to the command (see abstract, and column 8, line 49-column 9, line 16), while maintaining the associated image forming conditions in the memory, acquiring new image data and storing the new image data in the image memory (column 9, line 17-column 10, line 29), and printing a new image on a paper, based on the new image data acquired after the discarding of image data from the image memory, under the image forming conditions maintained in the mode memory (column 3, line 50-column 4, line 22, and column 9, line 17-column 10, line 29).

Regarding *claim 17*, Kawabuchi discloses the image forming method discussed above in claim 16, and further teaches of the step of changing the maintained image forming conditions (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Regarding **claim 18**, Kawabuchi discloses the image forming method discussed above in claim 16, and further teaches of the step of printing image data of another print job on a waiting list after the newly acquired image data has completely been printed (column 3, line 50-column 4, line 22, and column 9, line 17-column 10, line 29).

Regarding **claim 20**, Kawabuchi discloses the image forming apparatus discussed above in claim 1, and further teaches that the storing image forming conditions for the image data in a memory, the image forming conditions being at least one of number of copies, magnification and paper size (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Regarding **claim 21**, Kawabuchi discloses the image forming apparatus discussed above in claim 10, and further teaches that the storing image forming conditions for the image data in a memory, the image forming conditions being at least one of number of copies, magnification and paper size (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Regarding **claim 22**, Kawabuchi discloses the image forming method discussed above in claim 16, and further teaches that the storing image forming conditions for the image data in a memory, the image forming conditions being at least one of number of copies, magnification and paper size (column 3, line 55-column 4, line 4, and column 4, line 37-column 5, line 7).

Allowable Subject Matter

7. **Claims 19 and 23** are allowed.
8. **Claim 13** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2625

9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding *claims 13 and 19*, in the examiner's opinion, it would not have been obvious at the time of the invention to have the apparatus, as claimed, include the features of print control unit that gives priority to a new job for printing under the maintained forming conditions over the rest of the jobs on a waiting list.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

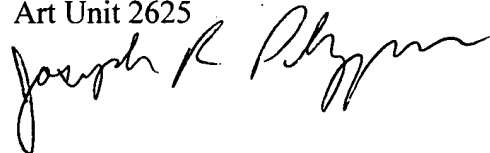
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

Art Unit: 2625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2625



jrp